

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

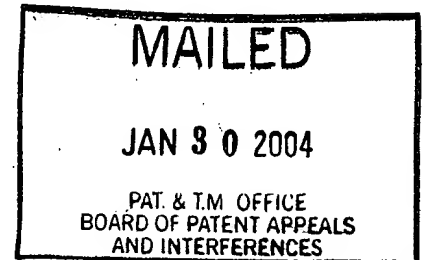
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES A. STOCKMAN

Appeal No. 2004-0230
Application 09/615,683

ON BRIEF



Before FRANKFORT, STAAB, and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

James A. Stockman appeals from the final rejection of claims 1 through 23, all of the claims pending in the application.

THE INVENTION

The invention relates to a combination backpack and chair.

Representative claim 1 reads as follows:

1. A backpack and chair apparatus, comprising:
 - a storage pack;
 - a frame attached to said storage pack, providing rigid structure and back support;
 - a plurality of straps attached to said frame enabling a person to carry said frame and said storage pack on one's back in a backpack mode;

a sub-frame pivotally attached to said frame and capable of being pivoted from the backpack mode to a chair mode thereby enabling a person to sit on the apparatus as a chair;

a locking assembly pivotally attached to said sub-frame and capable of being pivoted from a backpack mode enabling position to a chair mode locking position to lock and secure the sub-frame when in the chair mode so that the apparatus remains in the chair mode when sat on by a person.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Fisher	1,331,145	Feb. 17, 1920
Black	3,315,856	Apr. 25, 1967
MacLean	5,536,064	Jul. 16, 1996
Gatling	5,927,575	Jul. 27, 1999

THE REJECTIONS

Claims 1 through 23 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which is non-enabling with respect to the subject matter claimed.

Claims 18, 22 and 23 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which lacks written descriptive support for the subject matter claimed.

Claims 1 through 23 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

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Claims 1, 2, 4 through 6, 9, 10, 12, 19 and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Black.

Claims 3, 11 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Black in view of MacLean.

Claims 7, 8, 13, 14, 16 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Black in view of Fisher.

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Black in view of Fisher and MacLean.

Claims 17, 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Black in view of Fisher and Gatling.

Attention is directed to the brief (Paper No. 13) and the answer (Paper No. 14) for the respective positions of the appellant and the examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 112, first paragraph, rejection of claims 1 through 23 as being based on a specification which is non-enabling

The dispositive issue with respect to the enablement requirement of § 112, ¶ 1, is whether the inventor's disclosure, considering the level of ordinary skill in the art as of the date of the application, would have enabled a person of such skill to

make and use the claimed invention without undue experimentation.

In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

The examiner considers the appellant's specification to be non-enabling with regard to a backpack and chair apparatus having a locking assembly as recited in the appealed claims due to a vague description of the manner in which the so-called "latch" component of the locking assembly, i.e., bottom frame brace catch 12 and locking brace catch 13, operates and performs. Although the appellant's specification and drawings convey little detail as to the catches 12 and 13, the subject matter involved is a rather simple and straightforward mechanical expedient. The examiner has not cogently explained, and it is not apparent, why a person of ordinary skill in the art would not be able to make and use, without undue experimentation, a back pack and chair apparatus having a locking assembly with a "latch" as broadly disclosed by the appellant.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, non-enablement rejection of claims 1 through 23.

II. The 35 U.S.C. § 112, first paragraph, rejection of claims 18, 22 and 23 as being based on a specification which lacks written descriptive support

The test for determining compliance with the written description requirement of § 112, ¶ 1, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of the drawings may also be considered in determining compliance with the written description requirement. Id. Claims 18-23 were added to the application in an amendment filed November 27, 2001 (paper no. 5).

Claim 18, which depends from claim 1, recites a strap attached to the sub frame operative as a sway brace when in the chair mode. The original disclosure in this application does not describe or depict such a strap. Although the original disclosure does identify a brace strap 26, this strap is attached to slats 7 and 7A on the frame and locking assembly, respectively, not to any part of the sub frame.

Claim 22, which depends indirectly from claim 1, recites cushion-attaching side release buckles. The original disclosure in this application does not describe or depict such side release

buckles. The only cushion-attaching structure identified in the original disclosure is "a lightweight nylon strap with plastic snaps" (specification page 7; also see Figure 4).

Claim 23, which depends indirectly from claim 6, further defines the locking assembly as comprising a male locking brace¹ and a female brace catch that interconnect to secure the locking assembly. This subject matter finds adequate support in the original disclosure's description and depiction of catches 12 and 13.

Thus, the disclosure of the application as originally filed would reasonably convey to the artisan that the appellant had possession at that time of the subject matter recited in claim 23, but not the subject matter recited in claims 18 and 22. Therefore, we shall sustain the standing 35 U.S.C. § 112, first paragraph, lack of written description rejection with respect to claims 18 and 22, but not with respect to claim 23.

III. The 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 23 as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention

For the most part, this rejection rests on the examiner's misgivings about the appellant's disclosure of the so-called

¹ The reference to the "male locking brace" in claim 23 should instead be to a --male locking brace catch--.

"latch" component (catches 12 and 13) of the locking assembly. For the reasons discussed above in conjunction with the 35 U.S.C. § 112, first paragraph, non-enablement rejection, these concerns are unfounded. The examiner also questions how the strap recited in claim 18 can operate as a sway brace if attached only to the sub frame. Claim 18, however, does not require that the strap be attached "only" to the sub frame.²

Thus, the examiner's determination that claims 1 through 23 are indefinite is unfounded. Hence, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of these claims.

IV. The 35 U.S.C. § 102(b) rejection of claims 1, 2, 4 through 6, 9, 10, 12, 19 and 23 as being anticipated by Black

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only

² To the extent that claim 18 is intended by the appellant to be directed to the brace strap 26 which is not connected to the sub frame, it would be deserving of a 35 U.S.C. § 112, second paragraph, rejection on the basis of inaccuracy (see In re Knowlton, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973)).

that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Black discloses "a combined packboard and folding stool to be used by hunters, hikers, vacationers, picnickers and the like" (column 1, lines 8 through 10). As shown in Figures 1 through 6, the combination includes a main frame 2, a pack sack 7 and shoulder straps 25 attached to the main frame, a seat frame 1 pivotally connected to the main frame, a seat 16 formed by a piece of canvas, leather or the like attached to the seat frame, a leg frame 3 pivotally connected to the seat frame, means 13-15 for locking the seat frame to the main frame in a deployed position, and a spring loaded hinge connection 24 between the leg and seat frames to hold them at right angles in the deployed position.

As framed and argued by the appellant, the dispositive issue with respect to the examiner's determination that the subject matter recited in independent claim 1 is anticipated by Black is whether the reference meets the "chair" limitations in the claim.

According to the appellant, Black discloses a stool rather than a chair.

During patent examination claims are to be given their broadest reasonable interpretation consistent with the underlying specification without reading limitations from the specification into the claims. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). Webster's New Collegiate Dictionary (G. & C. Merriam Co. 1977) defines the term "chair" consistently with the appellant's specification as meaning "a seat typically having four legs and a back for one person." As best shown in Figures 1 and 3, Black's stool meets this definition as it has four legs and a back for one person. Moreover, even if this prior art structure were construed as not having a back, it would still meet the foregoing definition since such does not actually require a chair to have a back. Notwithstanding the appellant's arguments to the contrary (see page 35 in the brief), claim 1 does not explicitly call for a chair which has a back, which is structurally rigid or which is of normal household size.

Thus, the appellant's position that the "chair" limitations in claim 1 distinguish the subject matter recited therein over Black is not persuasive.

In addition, Black's seat frame 1 and main frame 2 respectively constitute a sub frame and frame meeting all of the limitations in claim 2 which depends from claim 1.

Accordingly, we shall sustain the standing 35 U.S.C. § 102(b) rejection of claims 1 and 2 as being anticipated by Black.

Claims 4 and 5, which depend from claim 1, further define the claimed backpack and chair apparatus as comprising a cushion. Independent claim 6, and claims 9, 10, 12 and 23 which depend therefrom, also call for a backpack and chair apparatus comprising a cushion. The examiner's finding (see page 6 in the answer) that the piece of canvas or leather which constitutes Black's seat 16 is a "cushion" is inconsistent with the ordinary and accustomed meaning of this term.³

Hence, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claims 4 through 6, 9, 10, 12 and 23 as being anticipated by Black.

Claim 19, which depends from claim 1, further defines the claimed backpack and chair apparatus as comprising a plurality of seat braces operative as stabilizers to prevent the chair from

³ For example, Webster's New Collegiate Dictionary (G. & C. Merriam Co. 1977) defines a "cushion" as "a soft pillow or pad usu. used for sitting, reclining, or kneeling."

collapsing forward. The examiner's determination (see page 6 in the answer) that the horizontal pack sack support on the bottom of Black's main frame embodies such braces stems from an unreasonable interpretation of the claim language in question.

Thus, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claim 19 as being anticipated by Black.

V. The 35 U.S.C. § 103(a) rejection of claims 3, 11 and 20 as being unpatentable over Black in view of MacLean

Claims 3 and 20, which depend from claim 1, and claim 11, which depends from independent claim 6, require the storage pack and frame to be removably attached.

Conceding that Black does not meet these limitations, the examiner turns to MacLean's disclosure of a combination backpack and chair having commonly used fasteners 32a-f for removably attaching the backpack and chair and concludes in view of this teaching that it would have been obvious to removably attach Black's pack sack 7 and main frame 2 "to increase utility of the pack by use without the frame if so desired" (answer, page 7). As the MacLean reference provides factual support for this motivation in the last four lines of its Abstract, the proposed modification of the Black apparatus is well founded.

We shall therefore sustain the standing 35 U.S.C. § 103(a) rejection of claims 3 and 20 as being unpatentable over Black in view of MacLean.

We shall not sustain, however, the standing 35 U.S.C. § 103(a) rejection of claim 11 as being unpatentable over Black in view of MacLean since the examiner's application of MacLean does not overcome Black's failure to meet the cushion limitation in parent claim 6.

VI. The 35 U.S.C. § 103(a) rejection of claims 7, 8, 13, 14, 16 and 23 as being unpatentable over Black in view of Fisher

Claims 7, 8 and 23, which depend from claim 6, independent claim 13, and claims 14 and 16, which depend from claim 13, further define the locking assembly of the claimed backpack and chair apparatus as comprising one or more jointed swing arms pivotally attached at one end to the sub frame and removably attachable at the other end to the frame such that one segment of each jointed swing arm acts as a chair leg in the chair mode. Conceding that Black's apparatus does not have this feature, the examiner cites Fisher. In short, there is nothing in Fisher's disclosure of a collapsible chair which is significantly more complicated than the stool disclosed by Black which would have suggested modifying the relating simple stool of Black to include jointed swing arms of the type at issue.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 7, 8, 13, 14, 16 and 23 as being unpatentable over Black in view of Fisher.

VII. The 35 U.S.C. § 103(a) rejection of claim 15 as being unpatentable over Black in view of Fisher and MacLean

Claim 15, which depends from claim 13, requires the storage pack and frame to be removably attached. As MacLean does not cure the above noted shortcomings of Black and Fisher relative to the subject matter recited in claim 13, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 15 as being unpatentable over Black in view of Fisher and MacLean.

VIII. The 35 U.S.C. § 103(a) rejection of claims 17, 21 and 22 as being unpatentable over Black in view of Fisher and Gatling

Claim 17, which depends indirectly from claim 13, requires the claimed backpack and chair apparatus to comprise a cushion with a zipper for ease of removal. Claim 21, which depends indirectly from claim 1, requires the claimed backpack and chair apparatus to have a cushion which is wedge shaped. Claim 22, which depends from claim 5, requires the claimed backpack and chair apparatus to have a cushion attached to the sub frame using side release buckles. To cure Black's admitted failure to meet these limitations, the examiner relies on Gatling's disclosure of a cushion and backpack assembly having a seat support cushion 6

comprising a filling of foam contained within a shell of canvas.

Since Gatling would have suggested providing the Black apparatus with a cushion, wedge shaped as a simple matter of design choice, to provide the user with additional comfort as proposed by the examiner (see page 8 in the answer), we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 21 as being unpatentable over Black in view of Fisher.⁴

Gatling, however, does not remedy the above noted shortcomings of the Black and Fisher combination relative to independent claim 13. Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claim 17 as being unpatentable over Black in view of Fisher and Gatling.

Gatling also would not have suggested the use of side release buckles to attach a cushion to a sub frame. Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 22 as being unpatentable over Black in view of Fisher and Gatling.

⁴ In the event of further prosecution, the examiner should consider whether the references applied above against claims 4 through 6 and 9 through 12 in further combination with Gatling's disclosure of a cushion and backpack assembly having a seat support cushion warrant new 35 U.S.C. § 103(a) rejections of these claims.

SUMMARY

In light of the foregoing analysis, the decision of the examiner:

a) to reject claims 1 through 23 under 35 U.S.C. § 112, first paragraph (enablement requirement), is reversed;

b) to reject claims 18, 22 and 23 under 35 U.S.C. § 112, first paragraph (written description requirement), is affirmed with respect to claims 18 and 22 and reversed with respect to claim 23;

c) to reject claims 1 through 23 under 35 U.S.C. § 112, second paragraph, is reversed;

d) to reject claims 1, 2, 4 through 6, 9, 10, 12, 19 and 23 under 35 U.S.C. § 102(b) as being anticipated by Black is affirmed with respect to claims 1 and 2 and reversed with respect to claims 4 through 6, 9, 10, 12, 19 and 23;

e) to reject claims 3, 11 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Black in view of MacLean is affirmed with respect to claims 3 and 20 and reversed with respect to claim 11;

f) to reject claims 7, 8, 13, 14, 16 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Black in view of Fisher is reversed;

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g) to reject claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Black in view of Fisher and MacLean is reversed; and


h) to reject claims 17, 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Black in view of Fisher and Gatling is affirmed with respect to claim 21 and reversed with respect to claims 17 and 22.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

CHARLES E. FRANKFORT
Administrative Patent Judge

Lawrence J. Staab
LAWRENCE J. STAAB
Administrative Patent Judge


JOHN P. MCQUADE
Administrative Patent Judge

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